

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 1-15 and 21 are pending in the application. Claims 1 and 8 are independent and are amended. Claim 21 is added. No new matter is involved.

Support for the amendments to claims 1 and 8, and for new claim 21, is found throughout Applicant's Application as originally filed including, for example, the descriptions of Figs. 6 and 7A through 7F. With respect to claim 21, reference is made, for example, to page 11, lines 4-15 of the original specification.

Reconsideration of this application, as amended, is respectfully requested.

Drawings

In the Amendments filed on July 29, 2004 and January 5, 2005, Applicants noted their belief that the drawings comply with U.S.P.T.O. requirements, and asked for a form PTO-948, indicating that the drawings have been approved by the Official Draftsperson. Applicants again respectfully request an indication, e.g., a Form PTO-948, that the drawings comply with USPTO requirements.

Claim Rejections under 35 U.S.C. 102

Claims 1 and 8 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 6,078,365 to Ueda et al. (hereinafter, "Ueda"). This rejection is respectfully traversed.

Claims 1 and 8 recite a combination of features which are not disclosed by Ueda.

Claim 1, as amended, positively recites a combination of features, including source and drain electrodes over the first metal layer, the source and drain electrodes adapted to be used to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the first metal layer and to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers, which are neither disclosed nor suggested by any of the applied art.

Claim 8, as amended, positively recites a number of features, including patterning the first metal layer and the second semiconductor layer in a same pattern by etching using the source and drain electrodes as a mask to expose the active layer between the source and drain electrodes such that the defined outer edge of the first metal layer is lined up with the defined outer edge of the second semiconductor layer to define a separation region and to reduce over-etching of the first metal layer, which are neither disclosed nor suggested by any of the applied art.

Moreover, with respect to claim 1, Applicants respectfully submit that claim 1 positively recites structural features of the source and drain electrodes to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the

first metal layer and to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers.

In this regard, Applicants refer to the decision by the Court of Customs and Patent Appeals in In re Venezia, 189 USOQ 149 (CCPA 1976). In that case, a number of claims were presented. Claim 31 with emphasis, was representative of the claims on appeal and read, as follows:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location*.

The Court reviewed the disputed claims and in particular the language criticized by the Examiner and the Board, and concluded that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly that they are, therefore, definite as required by the second paragraph of section 112. As the Court viewed these claims, they precisely define a group or "kit" of interrelated parts. The Court continued by stating:

These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, *supra*.

Applicant respectfully submits that present claim 1, by reciting "source and drain electrodes over the first metal layer, the source and drain electrodes adapted to be used to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the first metal layer and to define a first upper portion of the separation region that abuts the lined up

outer edges of the first and second semiconductor layers” is positively reciting present structures or attributes of the liquid crystal display device by defining the structures of the components of the completed liquid crystal display device in terms of the interrelationship of the components, or the attributes they must possess, in the completed device, which limits the structure of the liquid crystal display device to what is recited.

Ueda fails to disclose or suggest the positively recited features of claims 1 and 8. Accordingly, this rejection of claims 1 and 8 is improper and should be withdrawn.

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants’ admitted prior art (APA) in view of U.S. Patent 6,078,365 to Ueda et al. (hereinafter, “Ueda”). This rejection is respectfully traversed.

In the first place, Applicants have not admitted that Figures 1-5 are prior art to them. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicants have done is to refer to Figs. 1-5 as “Conventional” art. Something can be conventional art in the sense that it is practiced in the real world at the time of Applicants’ filing of this Application and yet may not be prior art to Applicants in any sense, including, for

example, under 35 U.S.C. §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 U.S.C. § 103(c).

Under the circumstances, i.e., where Applicants merely describe Figs. 1-5 as conventional art, the Office Action has not established that Applicants have made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Figs. 1-5 is prior art to Applicants. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a *prima facie* case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

Applicants respectfully submit that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that Figs. 1-5 are prior art to Applicants.

In reply to this argument, the Office Action speculates that inclusion of a discussion of Figs. 1-5 as conventional art in the Background of the Invention portion of the Specification is consistent with the requirement of MPEP §608.01(c)(2) to disclose prior art. The Office Action also references MPEP §707.05(b) which states that MPEP §609 sets forth guidelines for submitting prior art for consideration by the USPTO and speculates even further that Applicants' arguments might be improper.

Applicants respectfully disagree with these rebuttal arguments for the following reasons:

In the first place, MPEP §608.01(c) clearly states that the background of the invention includes paragraphs “describing . . . the state of the prior art or to other information disclosed known to the applicant . . .” (emphasis added). Clearly, this section of the MPEP readily distinguishes between “prior art” and “other information.” Accordingly, MPEP §608.01(c) cannot logically be used as a basis for concluding that “conventional art” discussed in the Background of the Invention portion of the specification is prior art just because it is described as such in that portion of the specification. By the express terms of MPEP §608.01(c), “conventional art” disclosed in the background of the invention logically can be “other information,” i.e., not prior art.

In the second place, the references to MPEP §707.05(b) and §609, which discuss information disclosure statements, are clearly misplaced. Applicants have not listed Figs. 1-5 of this Application on an Information Disclosure Statement. Furthermore, MPEP §609 clearly states that “. . . the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b). 37 CFR 1.97(h). See MPEP §2129 regarding admissions by Applicant.” MPEP 2129 clearly points out that listing of a reference in an IDS is not taken as an admission that the reference is prior art against the claims. In this regard, also see Abbott Laboratories v. Baxter Pharmaceutical Products Inc., 67 USPQ2d 1191 (CAFC 2003).

MPEP 2129 also points out that only where the specification identifies work done by another as “prior art” is it treated as admitted prior art. In this case, Applicants have neither

stated that the “conventional art” is “by another” or that it is “prior art.” Thus, the only basis on which the MPEP permits one to treat art disclosed in the specification as prior art does not apply to the situation present in this Application.

In the third place, Applicants respectfully submit that they have not done anything improper, the possibility of which is alleged on page 13 of the Office Action. Applicants are arguing that a statement in the specification by Applicants that something is “conventional art” is not, in and of itself, a clear, unmistakable and unequivocal admission that what is “conventional art” is “prior art,” and that the Office Action’s conclusion to the contrary is not supported by the sections of the MPEP cited to support that contrary conclusion. In fact, under the circumstances, it is only the Office Action’s rejection that is improper in the sense that it improperly treats Applicants Figs. 1-5 and its corresponding description, as admitted prior art to Applicants.

Moreover, claim 1, as amended, positively recites a combination of features, including source and drain electrodes over the first metal layer, the source and drain electrodes adapted to be used to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the first metal layer and to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers, which are neither disclosed nor suggested by any of the applied art.

Furthermore, claim 8, as amended, positively recites a number of features, including patterning the first metal layer and the second semiconductor layer in a same pattern by etching using the source and drain electrodes as a mask to expose the active layer between the source and drain electrodes such that the defined outer edge of the first metal layer is lined up with the defined outer edge of the second semiconductor layer to define a separation region and to reduce

over-etching of the first metal layer, which are neither disclosed nor suggested by any of the applied art.

Additionally, with respect to claim 1, Applicant respectfully submits that claim 1 positively recites structural features of the source and drain electrodes to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the first metal layer and to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers.

In this regard, Applicants refer to the decision by the Court of Customs and Patent Appeals in In re Venezia, 189 USOQ 149 (CCPA 1976). As noted above, in that case, a number of claims were presented. Claim 31 with emphasis, was representative of the claims on appeal and read, as follows:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal

bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location.*

The Court reviewed the disputed claims and in particular the language criticized by the Examiner and the Board, and concluded that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly, and that they are, therefore, definite as required by the second paragraph of section 112. As the Court viewed these claims, they precisely define a group or "kit" of interrelated parts. The Court continued by stating:

These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves * * * each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves * * * are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these

claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, supra.

Applicant respectfully submits that claim 1, by reciting “source and drain electrodes over the first metal layer, the source and drain electrodes adapted to be used to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the first metal layer and to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers” is positively reciting present structures or attributes of the liquid crystal display device by defining the structures of the components of the completed liquid crystal display device in terms of the interrelationship of the components, or the attributes they must possess, in the completed device, which limits the structure of the liquid crystal display device to what is recited.

It is respectfully submitted that the combinations of elements and steps recited in independent claims 1 and 8 are not disclosed or made obvious by the applied art of record including the alleged APA and Ueda et al.

The device claims positively recite structural features which are not found in the alleged admitted prior art or in Ueda. The method claims also recite features that are not disclosed by the alleged admitted prior art or Ueda.

Accordingly, even if it were proper to modify the alleged APA in view of Ueda, the resulting reference combination would not meet, or render obvious, the claimed invention.

The Office Action relies on Figs. 15A-15F of Ueda et al. However, an inspection of those figures reveals a structure significantly different from that claimed. For example, Ueda

does not disclose “source and drain electrodes over the first metal layer, the source and drain electrodes adapted to be used to pattern by etching the semiconductor layers in the same pattern as the first metal layer to reduce over etching of the first metal layer and to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers,” as recited in claims 1-7, or “patterning the first metal layer and the second semiconductor layer in a same pattern by etching using the source and drain electrodes as a mask to expose the active layer between the source and drain electrodes such that the defined outer edge of the first metal layer is lined up with the defined outer edge of the second semiconductor layer to define a separation region and to reduce over-etching of the first metal layer,” as recited in claims 8-15.

Because neither reference discloses a number of claimed features, as indicated above, they do not render obvious the invention recited in claims 1-15.

Furthermore, Applicants respectfully submit that the Office Action does not make out a *prima facie* case of proper motivation to modify the alleged APA in view of Ueda. In other words, the Office Action fails to provide any objective evidence of proper motivation to modify Figs. 1-5, which have not been established to be prior art to Applicants, in view of the secondary reference to Ueda.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have

been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Ueda is directed to preventing peeling of a metal mask (col. 2, lines 30-38). However, the "conventional" art disclosed by Applicants is not disclosed as exhibiting that problem.

As stated by the CCPA in the case of In re Spinnoble, 56 CCPA 823, 405 F.2d 578, 866 O.G. 341, 160 USPQ 237, 243,

"* * * a patentable invention may lie in the discovery of the source of a problem

even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103."

Moreover, just because the references are from the same field of endeavor does not provide proper motivation to modify one in view of the other. A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). In other words, the broad conclusory statement that "ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation" to modify the alleged APA in view of Ueda is not clear and particular enough to constitute evidence of proper motivation.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the claimed invention.

The Office Action allegedly addresses the following detailed argument presented on pages 11-13 of the Amendment filed July 29, 2004:

Ueda is directed to preventing peeling of a metal mask (col. 2, lines 30-38. However, the "conventional" art disclosed by Applicants is not disclosed as does not exhibiting that problem. Moreover, just because the references are from the same field of endeavor does not provide proper motivation to modify one in view of the other. A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). In other words, the broad conclusory statement that

“ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation” to modify the alleged APA in view of Ueda is not clear and particular enough to constitute evidence of proper motivation.

The Office Action does not address Applicant’s argument that the allegedly admitted prior art does not disclose any problem with the prior art that Applicant recognized and used as the basis for modifying the prior art. This failure to address the fact that the allegedly admitted prior art is oblivious to the need to be modified is evidence of improper hindsight reconstruction of Applicant’s invention based solely on Applicant’s recognition of a problem in the conventional art.

As such, this rejection is improper and should be withdrawn.

The Office Action also states, on page 7, that a reason to modify the LCD of the APA “with added source and drain electrodes over the first metal layer, the source and drain electrodes patterned the same as the first metal layer and the second semiconductor layer define first upper portion of the separation region, and the source and drain electrodes include a second and third metal layer in order to use a low resistance metal such as Aluminum for improved conductivity of the circuit components.”

Applicants respectfully submit that the Office Action has not established by factual objective evidence that the alleged APA needs to improve the conductivity of its circuit components – the alleged existence of such a need is pure speculation. As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded

assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Additionally, neither the allegedly APA nor Ueda discloses the aforementioned source and drain electrode masking features of claims 1 and 8.

Accordingly, claims 1 and 8 are not rendered obvious by the applied art.

Applicants present the following additional rebuttal to the arguments presented on pages 12-15 of the Office Action.

The “Background of the Invention” section, according to MPEP §608.01 (c)(2), can describe “the related art” that includes not only prior art but also “other information known to the applicant.” Nowhere does MPEP §608.01 (c)(2) indicate that the background of the invention section is limited to disclosures of prior art.

Applicants’ disclosure of Figs. 1-5 as “conventional” is entirely consistent with the guidance found in the aforementioned section of the MPEP because Figs. 1-5 are information known to Applicants that provide a background for someone reading the invention disclosure to understand the invention and its advantages.

Moreover, Applicants clearly stated, in the Amendment filed July 22, 2004, that something can be conventional art in the sense that it is practiced in the real world at the time of Applicants’ filing of this Application and may yet not be prior art to Applicants in any sense,

including, for example, under 35 U.S.C. §103, which forms the basis for this rejection, referencing in this regard, the relatively recent amendments to 35 U.S.C. §103(c).

The Office Action does not comment on this statement, and does not rebut the substance of the statement, which makes it clear that something can be conventional to Applicants whereas it may not be conventional to others and in no sense may be prior art to Applicants.

Additionally, Applicants respectfully submit that the basis for this rejection is that Figs. 1-5 constitute AAPA, i.e., an admission by Applicants that Figs. 1-5 are prior art to Applicants. Merely referring to Figs. 1-5 as conventional art is definitely not a clear, unmistakable and unequivocal admission that Figs. 1-5 are prior art to Applicants.

Applicant completely disagrees with the Office Action's assertion, on page 13, that it is Applicant's burden to provide evidence that what is described as conventional is not prior art to Applicant. This assertion contradicts established case law, cited above, holding that the burden is on the Office to make out a *prima facie* case that what Applicant describes as conventional is admitted prior art to Applicant.

Accordingly, the Office Action has not made out a *prima facie* case of Figs. 1-5 constituting prior art to Applicants, or a *prima facie* case of proper motivation to combine the applied references, or a *prima facie* case of obviousness of the claimed invention.

In view of the forgoing, it is respectfully submitted that the applied prior art of record, including the alleged APA and Ueda et al. fail to teach or suggest the combination of elements

and steps set forth in independent claims 1 and 8. It is believed that independent claims 1 and 8 are allowable. Because the remaining claims depend from these allowable independent claims, they are also allowable for at least the above reasons, as well as for the additional limitations provided thereby. Thus, claims 1-15 are allowable and reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

New Claim 21

Claim 21 has been added. It is similar to claim 8 but recites the simultaneous patterning of the first metal layer, the second semiconductor layer, and the ohmic contact layer in a same pattern by etching using the source and drain electrodes as a mask to expose the active layer between the source and drain electrodes such that the defined outer edge of the first metal layer is lined up with the defined outer edge of the second semiconductor layer to define a separation region and to reduce over-etching of the first metal layer.

Claim 21 patentably defines over the applied art at least for the reasons stated above regarding the rejections of claim 8, and for the additional reason that claim 21 requires the aforementioned simultaneous patterning feature.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No. 10/028,305
Amendment dated September 9, 2005
After Final Office Action of March 24, 2005

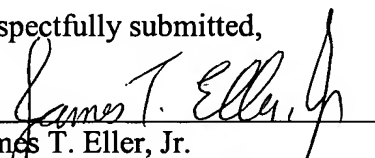
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 9, 2005

Respectfully submitted,

By


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